

REMARKS

The Final Office Action mailed August 12, 2008, has been received and reviewed. Claims 1 through 112 are currently pending in the application, of which claims 26 through 39 are currently under examination. Claims 1 through 25, and 40 through 112 are withdrawn from consideration as being drawn to a non-elected invention. Applicants propose to amend claims 26, 27, 29, 33, 34, and 36, and respectfully request reconsideration of the application as proposed to be amended herein.

Independent claim 26 is amended herein to recite “providing at least one patron an opportunity to select at least one runner from a list of runners; responsive to the at least one patron selecting the at least one runner, providing the at least one patron an opportunity to place at least one first wager on a race wherein the at least one runner makes up a portion of the at least one first wager.” Support for the amendment is found in the as-filed specification at least at paragraphs [0061]-[0062] and FIGs. 18-20.

Independent claim 33 is amended herein to recite “at least one patron is provided with an opportunity to select at least one runner from a list of runners displayed on the display element; the at least one patron is presented with an opportunity to place at least one first wager on a race displayed on the display element in response to the at least one patron selecting the at least one runner and wherein the at least one runner makes up a portion of the least one first wager.” Support for the amendment is found in the as-filed specification at least at paragraphs [0061]-[0062] and FIGs. 18-20.

Dependent claims 27, 29, 34, and 36 are amended herein for antecedent basis in light of the amendments to independent claims 26 and 33.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 6,554,709 to Brenner et al. in view of Design Choice

Claims 26 through 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brenner et al. (U.S. Patent No. 6,554,709) in view of Design Choice. Applicants respectfully traverse this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, the Examiner must determine whether there is “an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-1741, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Further, rejections on obviousness grounds “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id* at 1741, quoting *In re Kahn*, 441, F.3d 977, 988 (Fed. Cir. 2006). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

It is respectfully submitted that a *prima facie* case of obviousness has not been established against any of claims 26 through 39 because Brenner does not teach or suggest all of the claim limitations. Additionally, claims 26 through 39 would not have been an obvious design choice to one of ordinary skill in the art in light of the applied reference.

It is respectfully submitted that the applied reference does not teach or suggest all of the elements of independent claim 26, as amended herein, because Brenner does not teach or suggest “providing at least one patron an opportunity to select at least one runner from a list of runners; responsive to the at least one patron selecting the at least one runner, providing the at least one patron an opportunity to place at least one first wager on a race wherein the at least one runner makes up a portion of the at least one first wager.” Rather, as depicted in FIG. 3, Brenner teaches runners are selected at 244 *after* a wager type and amount are selected at 214 and 230, respectively. In the claimed method, the at least one patron must select at least one runner before

placing at least one first wager; however, Brenner does not teach or suggest selection of a runner *before* placing a wager.

Further, the examiner has not provided any evidence that “providing at least one patron an opportunity to select at least one runner from a list of runners; responsive to the at least one patron selecting the at least one runner, providing the at least one patron an opportunity to place at least one first wager on a race wherein the at least one runner makes up a portion of the at least one first wager” as recited in independent claim 26, as amended herein, would have been an obvious design choice to a person of ordinary skill in the art.

Accordingly, Brenner does not teach or suggest all of the elements of independent claim 26. Additionally, claim 26 would not have been an obvious design choice to one of ordinary skill in the art in light of Brenner. It is, therefore, respectfully submitted that a *prima facie* case of obviousness has not been established against independent claim 26.

The nonobviousness of independent claim 26 precludes a rejection of claims 27 through 32 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Claim 29 is further allowable as Brenner does not teach or suggest “responsive to the at least one patron placing the at least one first wager, providing the at least one patron an opportunity to select at least another runner; wherein the at least another runner makes up a portion of the at least one second wager.” Rather, as depicted in FIG. 3, Brenner teaches after placing a first bet, the user may make more bets on the same race at which point the user is returned to step 214, at which a new wager amount is selected followed by the type of wager 230 and finally the selection of runners 244. Brenner at col. 12 lines 29-33 and FIG. 3. As such, Brenner teaches that a user must select a wager amount and wager type *before* the user is provided an opportunity to select at least another runner.

Claim 30 is further allowable because Brenner does not teach or suggest generating a pool of wager options including the at least one runner and the at least another runner. Rather, Brenner teaches, as shown in FIG. 3, the patron selects a wager type at 230, and *then* selects runners at 244. Further, Brenner teaches, as shown in FIG. 15, a display of *all* runners, and not

just *selected* runners. Additionally Brenner does not teach or suggest displaying the pool of wager options to the at least one patron because Brenner teaches displaying the wager options at FIG. 14 *before* runners are selected.

Claim 31 is further allowable as Brenner does not teach or suggest a pool of wager options with an area marked representing the selected at least one runner. As noted above, Brenner teaches that the available wager options are displayed in FIG. 14 *before* runners are selected.

Claim 32 is further allowable as Brenner does not teach or suggest displaying tote data in conjunction with any wagers but, rather, Brenner teaches displaying tote data in conjunction with all the horses. *See* Brenner at FIG. 15. Further FIGS. 4 and 18-19 of Brenner do not teach or suggest displaying tote data in conjunction with any *wagers*.

Independent claim 33 is allowable for the same reasons set forth above with respect to independent claim 26.

Applicants respectfully note that there are no rejections asserted in the body of the Office Action addressing claims 36-39. Applicants assume this is an oversight, and respond as if rejections against claims 36-39 have been asserted.

Claims 34-39 are allowable as depending from independent claim 33 which is allowable.

Claim 36 is further allowable for the same reasons set forth above with respect to claim 29.

Claim 37 is further allowable for the same reasons set forth above with respect to claim 30.

Claim 38 is further allowable for the same reasons set forth above with respect to claim 31.

Claim 39 is further allowable for the same reasons set forth above with respect to claim 32.

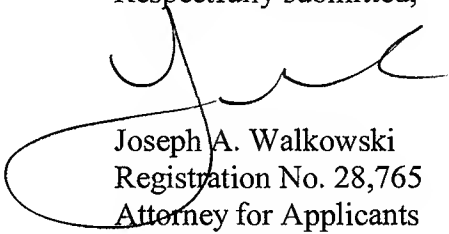
ENTRY OF AMENDMENTS

The amendments to claims 26, 27, 29, 33, 34, and 36 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

CONCLUSION

Claims 26 through 39 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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